UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,737	04/30/2001	Brian T. Murren	GE1-0006US	3462

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EXAMINER
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ART UNIT	PAPER NUMBER
2145	

NOTIFICATION DATE	DELIVERY MODE
03/06/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

lhpto@leehayes.com

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _06 February 2008_.
2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-30,48-51 and 58_ is/are pending in the application.
　　4a) Of the above claim(s) _31,47 and 52-57_ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) _1-30,48-51 and 58_ is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
　　a)☐ All b)☐ Some * c)☐ None of:
　　　　1.☐ Certified copies of the priority documents have been received.
　　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.
　　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments filed 2/6/2008 have been fully considered but they are not persuasive.

2.   Applicant argues based on *Telecom Inc. v. Datapoint Corp.* that one of ordinary skill in the art is a skilled programmer. Applicant argues this was not considered in the enablement rejection. One of ordinary skill is presumed to have programming experience. However, one of ordinary skill would not be able to implement Applicant's invention given Applicant's vague specification without suffering the burden of undue experimentation.

3.   When one of ordinary skill in the art who is a skilled programmer develops software, one of ordinary skill has an idea what the software will accomplish, and how that software will be structured. Applicant failed to provide any of those concepts in the specification and claims. Applicant generally refers to vague layers and domains. One of ordinary skill who is a skilled programmer would not be able to implement the invention based upon Applicant's vague description of the invention in the specification.

4.   Applicant argues that the electrical computer environment should be considered in the Wands test. Applicant argues that the breadth of the claims lowers the amount of disclosure necessary to enable a claim. Applying the needs of the computer art, a vague and broad claim such as submitted by Applicant would unnecessarily hinder one of ordinary skill from designing a general software framework for interconnecting the necessary software modules for programming, much less coding the instructions to implement the invention. One of ordinary skill would suffer the burden of undue experimentation in many ways. First, one of ordinary skill would be faced with interpreting Applicant's spec and claims into a generic software design before writing the code. Second, one of ordinary skill would have to implement the necessary code to get the modules to work properly. Third, one of ordinary skill would then have to see if the working software met the goals of Applicant's spec and claims.

5.   Applicant should be well aware that one of ordinary skill requires in-depth documentation before writing a program such as Applicant has claimed. One of ordinary skill cannot program Applicant's invention in a black hole; Applicant must provide one of ordinary skill with the necessary instructions to implement the invention.

6.   Applicant argues that the requirement of 112 first does not require source code. The rejection is not requiring source code, but source code would be one way of overcoming the deficiencies of the specification. The problem with enablement lies in the fact that Applicant gave random bits and pieces of information and said they create interchangeable layers. Applicant gave no indication to one of ordinary skill how these layers would be implemented. Applicant's own remarks refuse to provide one of ordinary skill with a concept of what a layer is, and Applicant apparently attempts to remove and/or disavow any prior statements regarding layers from the prosecution history.

7.   Applicant argues that the level of one of ordinary skill in the art is not considered, stating that "here the level of one of ordinary skill for electrical/computer inventions is a skilled programmer." Remarks, 2/6/2008, page 22. The rejection states that the inventor is considered to be one of ordinary skill. Applicant apparently admits the inventor is not a skilled programmer in the rebuttal, since the level of one of ordinary skill in the art (the inventor) was not considered. Therefore the level of ordinary skill Applicant argues for consideration of the Wands factors is above and beyond the level of ordinary skill possessed by the inventor.

8.   Applicant again argues that there is a requirement under 37 CFR 1.105 pending in this application, even though there is no such requirement currently pending. The only outstanding rejection or requirement in this application currently is a 112 first paragraph rejection for enablement utilizing the factors of *In re Wands*. Applicant is apparently arguing the *Wands* test of enablement is inapplicable to electrical patents because *Wands* was a biotech issue, but fails to show where in case law or the MPEP there is a different test of enablement utilized.

Claim Rejections - 35 USC § 112

9.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10.   Claims 1-30, 48-51 and 58 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the

specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

11.   As per MPEP 2164, The purpose of the [enablement] requirement that the specification describe the invention in such terms that one skilled in the art can make and use the claimed invention is to ensure that the invention is communicated to the interested public in a meaningful way. The information contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art how to both make and use the claimed invention.

12.   The test of enablement is "Any analysis whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of claims as to enable one skilled in the pertinent art to make and use the claimed invention…even though the statute does not use the term "undue experimentation", it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation." MPEP 2161.01

13.   MPEP 2164.01(a) details the factors presented by *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) to be considered in determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to:

    a.   The breadth of the claims: Applicant's own admissions speak to the breadth of the

    claims. Applicant stated the specification showed a "hierarchical organization of layers, which

    can be implemented as a hierarchical grouping of code modules. Hence, the term 'layer' would

    be well understood by one skilled in the art." One of ordinary skill in the art recognizes this

    definition to match the definition used for the OSI model of computer networking, which is a basic

    building block of networking theory. See Applicant Remarks, 4/28/2006, specifically Appendix B.

    In a telephonic interview conducted with Applicant's representative on 6/10/2006, the invention

    was described as an object-oriented software development environment. A response to a

    requirement for information under 37 CFR 1.105 revealed the invention was implemented as

    "GEtheSource", which is "a web-based asset management application developed for Global

Electronics Solutions business of GE Commercial Equipment Finance." Remarks of 9/12/2005,

page 41. Applicant has stated the claims are broad enough to cover the OSI model of computer

networking, object oriented programming, and web based credit card billing systems.

b.   The nature of the invention: The invention is believed to be a software development

system. This is supported by the original specification, page 2, lines 1-15.

c.   The state of the prior art: Object oriented software development platforms have been in

existence several years before the invention was created.

d.   The level of one of ordinary skill: The inventor of the application is considered to have

the level of one of ordinary skill.

e.   The level of predictability in the art: Networking is a predictable art. Unpredictable

results are not common.

f.   The amount of direction provided by the inventor; If the invention is an object oriented

software template, one of ordinary skill is unable to implement the specific invention based upon

the submitted information within the specification. Applicant provided a source code snippet on

page 57 of the specification for a login prompt for a screen. Table 5 gives another source code

snippet implementing this as a login function for JavaScript. Various object abstracts are

presented in Tables 18-30. Page 94 of the specification reiterates an HTML source code snippet

for the login prompt, which is compiled on page 96. Table 1 is a document type definition of basic

XML elements of data. Table 2 is "an example XML file for the asset catalog program." No

information is provided explaining how these code snippets and XML file fragments are

implemented as interchangeable layers. The closest information provided to an actual

implementation of an object oriented program can be found by example in Table 5. Lines 8-30 of

Table 5 call various functions, such as bIsGELength, bIsLELength, and

bValidateTextTagUserName. These appear to be non-functional variables which are not

referenced anywhere else in the specification, and are not called by any example in the

specification. Applicant therefore has provided no examples of the implementation of the layers

or domains that Applicant has claimed. One of ordinary skill has no foundational information to

work with in order to implement these crucial aspects of Applicant's invention.

g.   The existence of working examples; Applicant provided no working examples of the

invention to the Office for review and

h.   The quantity of experimentation needed to make or use the invention based on the

content of the disclosure: Applicant provided a vague description of a set of various "layers" used

to solve "problems" in "problem domains". Applicant referred to an "interfacing layer" in the

claims, but gave no indication in the specification to allow one of ordinary skill in the art to

interpret what this layer consisted of. The interfacing layer is never referenced in the specification

or drawings. Specification, page 8 – "Generally, the architecture 110 includes an execution

environment layer 202, a business logic layer 204, a data coordination layer 206, a data

abstraction layer 208, a service layer 210, and a presentation layer 212." Although page 15, lines

18-26 states "[t]he architecture 110 may include one or more other layers or modules…", the

subsequent text of that paragraph is directed to other modules which may be added to the

architecture, and not toward any "interfacing layer".

Conclusion

14.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth

in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from

the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date

of this final action and the advisory action is not mailed until after the end of the THREE-MONTH

shortened statutory period, then the shortened statutory period will expire on the date the advisory action

is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX

MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571)272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner
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